



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,139	03/09/2006	Marc Chaussade	1022702-000128	4927

21839 7590 09/05/2008
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
----------	--------------

1796

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

09/05/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/541,139	Applicant(s) CHAUSSADE ET AL.	
	Examiner Kuo-Liang Peng	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/9/06 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 1-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/9/06, 6/30/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' preliminary amendment filed June 30, 2005 is acknowledged. Claims 1-15 are amended. Now, Claims 1-15 are pending.

Specification

2. The disclosure is objected to because of the following informalities:

In the specification (page 18, lines 15-16), it is not clear as to what "SM₄: or at least one nonreactive (E) POS" refers to.

In the specification (page 24, lines 7-13), "if CA = CA I, then CA I is **different** from any" causes confusion because it is not clear as to how CA is CA I, yet CA is **different** from the CA previously defined as the species recited following the word "any".

Appropriate correction is required.

Claim Objections

3. Claims 1-15 are objected to because of the following informalities:

Applicants are advised to remove the unnecessary symbols, such as "▪", etc. and **unnecessary** underlines.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd.

App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 1 recites the broad recitation “optionally substituted” (line 14), and the claim also recites “preferably halogenated” (page 5, 6th line from bottom, page 6, line 3 and page 8, line 4) which is the narrower statement of the range/limitation. The following similar terms have the same issue: “preferably from disilazanes” (Claim 1, page 6, 4th to 5th line from bottom), “particularly preferred” (Claim 1, page 6, 3rd line from bottom), “preferably halogenated” (Claim 1, page 7, line 1 and Claim 15, line 6), “preferably from R^c-substituted” (Claim 1, page 7, line 1), “preferably $60 \leq r \leq 90$ ” (Claim 1, page 7, line 13), “preferably in the hot state” (Claim 1, page 7, line 16), “preferably while” (Claim 1, page 8, line 7), “preferably without” (Claim 1, page 8, 6th line from bottom), “advantageously” (Claim 2, page 10, line 3, Claim 4, page 11, 2nd line from bottom, Claim 13, page 14, line 5 and Claim 15, page 16, line 6), “for example” (Claim 2, page 10, line 5, Claim 3, line 17 and Claim 4, page 12, line 1), “such as” (Claim 2, page 10, line 5, Claim 3, lines 12 and 17 and Claim 4, page 12, line 1), “more particularly” (Claim 2, last line, Claim 3, last line and Claim 4, last line), “in particular” (Claim 3, line 12), “preferably” and “more preferably” (Claim 4, lines 11 and 13, Claim 7, lines 3 and 6, Claim 8, line 3, Claim 10, lines 3-4, Claim 11, lines 3-4 and Claim 13, line 10) and “preferably” (Claim 5, line 3, Claim 6, line 3, Claim 7, lines 3 and 6, Claim 9,

Art Unit: 1796

line 3, Claim 13, lines 5 and 7, Claim 13, page 14, lines 4 and 9, Claim 15, page 16, lines 5 and 11).

Claim 1 recites the limitation "*Fc*" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the compatibilizing agent (CA)" in page 6, 6th line from bottom. There is insufficient antecedent basis for this limitation in the claim.

In Claim 1 (page 7, line 8), it is not clear as to what "**qualitatively** identical to or different from each other" refers to. (Emphasis added)

In Claim 1 (page 8, 5th line from bottom), it is not clear as to what "passing via a dried hydrophobic silica" refers to.

Claim 2 recites the limitation "C1" in line 10. There is insufficient antecedent basis for this limitation in the claim.

In Claims 2-4, the condition "**without** excluding:" is not adequately supported in Claim 1. (Emphasis added)

Claim 3 recites the limitation "C2" in line 10. There is insufficient antecedent basis for this limitation in the claim.

In Claim 4 (line 12), it is not clear as to how strong the strong bases is.

In Claim 10, it is not clear as to which claim it depends on.

In Claim 13 (page 14, line 7), “or” causes confusion because the will be no polyaddition composition.

In Claim 14 (page 15, line 10), “or” causes confusion because the will be no polycondensation composition.

In Claim 15 (page 16, line 6), "Si-Vi groups" causes confusion because a POS containing Si-Vi groups cannot not be a reactive constituent in a polyhydrogenocondensation composition.

In Claim 15 (page 16, line 8), “or” causes confusion because the will be no polyhydrogenocondensation composition.

For Claims 1-15, in addition to the forgoing issues, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1796

7. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In Claim 1 (page 6, lines 10-11), it is not clear as to what “SM₄: or at least one nonreactive (E) POS” refers to. Notably, the same language is used in the specification, *supra*.

In Claim 3 (lines 10-16), "if CA = CA I, then CA I is **different** from any" causes confusion, *supra*.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (FR 2 817 262).

The following column and line numbers are based on Jackson's U.S. equivalent, US 2004 0044113.

For Claims 1-6 and 8-11, Jackson discloses a method for preparing a suspension of a silica in a silicone material usable for production of silicones (SM) crosslinkable by polyaddition **and/or** polycondensation where a compatibilizer (CA) such as organosilazanes, etc. can be employed. A non-reactive polysiloxane can optionally present. (Abstract, [0068]-[0095], [0114], [0157] and Examples) The polycondensation curable polysiloxane (SM) can have a formula (1) that can optionally contain T and/or Q units, which can correspond to the claimed CA III. ([0192], [0210]and [0287]-[0290])) The SM can be added after the addition of the compatibilizer. ([0089]) The silica can be in the form of a powder or the form of an aqueous slurry. ([0114]) Water , if added, can be in the amount described in [0081]-[0083]. For Claims 7 and 12, the BET of the silica (e.g., precipitated silica) and the viscosity of the suspension are illustrated in [0116] and [0303]. For Claim 13, the polyaddition SM is further described in [0175] to [0182]. For Claim 14, the polycondensation SM is further described in [0191] to [0220]

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canpont (WO 00/37549).

The following column and line numbers are based on Canpont's U.S. equivalent, US 6 462 104.

For Claims 1-5, 8-11 and 14, Canpont discloses a method for preparing a suspension of a silica in a silicone material including a reactive POS, water, optionally a non-reactive POS to produce silicone compositions that can be cured by polycondensation where a compatibilizer such as organosilazanes, etc. can be employed. (col. 3, lines 27 to 54, col. 4, lines 29-36, col. 6, line 58 to col. 8, line 14 and Examples) The non-reactive POS can contain T and/or Q units (i.e., a POS resin)(col. 7, line 58 to col. 8, line 14) The method is further elaborated in col. 4, line 37 to col. 6, line 48. A tin or titanium salt can be used as a catalyst. (col. 9, line

Art Unit: 1796

60 to col. 10, line 10) The incorporation of silicone material (SM) can take place after the silica (filler) has been treated with a compatibilizer (CA). (col. 3, lines 41-54) Canpont is silent on the claimed amount of the water. However, the amount of the water will affect the rate of hydrolysis of organosilazane and in turn the efficiency of the silica surface treatment and/or the curing rate of the silicone compositions. In other words, the water amount is a Result-Effective variable. Therefore, it would have been obvious to incorporate water in whatever amount through routine experimentation in order to afford a composition having proper surface treatment of the silica and/or a desired curing rate. Especially, Applicants do not show the criticality of the water amount. For Claim 6, the amount of the unreacted POS (a POS resin, *supra*) (corresponding to CA III) with respect to the filler can be described in col. 4, lines 43-46 and col. 9, lines 15-24. For Claims 7 and 12, the BET of a silica such as precipitated silica is described in col. 4, lines 16-28. The viscosity of the suspension is exemplified in col. 3, lines 1-11.

12. The “X” references cited in the international search report are not relied upon because of the following reasons:

These “X” references are not better than those applied above.

13. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

None of the foregoing references teaches or fairly suggests the claimed process where a polyhydrogenocondensation SM is employed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

Art Unit: 1796

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
September 2, 2009

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796